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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,199	08/20/2003	Patricia A. Kelly	42833-0200	5744
21611 7590 05/16/2007 SNELL & WILMER LLP (OC) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			EXAMINER DESANTO, MATTHEW F	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/644,199

Applicant(s)

KELLY ET AL.

Examiner

Matthew F. DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-32 and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 37, and 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 37 is indefinite because of the limitations of the second end receiving the teat of a human breast while the first end receives the areola, while the first end is connected to the vacuum source, thus causing confusion since the above limitations as read with regards to the specification would mean that the second end would have to be attached to the vacuum source, since the second end is the portion that is referred to as reference numbers 113 in the instant application since that is the portion that receives the teat of the human breast.

4. Claim 39 is indefinite because claim 39 depends on claim 22, which claims the second end receiving the areola of the breast. This fails to follow the scope of the claims, which are that the receiving end has a larger wall thickness, while the other end that is in the housing has a thinner wall thickness, therefore the claims are indefinite since the limitations don't follow any embodiment in the instant application.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3763

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22-32, and 37-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver et al. (USPN 6,663,587).

Silver et al. discloses breast cup for use in a breast pump system comprising: a cup of collapsible biocompatible material having a first cross-section and an opening at a first end which is connected to a vacuum line (48), and a second cross-section and an opening at a second end, the wall thickness of the cup varying from the first end to the second end in a manner that causes a progressive collapse of the cup when a vacuum is drawn at the first end, and the second end of the cup is closed by a human breast and teat, and wherein the second cross-section (see figures 1, 2, 6 and entire reference).

7. Claims 22-32, 37-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Atkins et al. (USPN 6,579,258).

Atkins et al. discloses breast cup for use in a breast pump system comprising: a cup of biocompatible material having a first cross-section and an opening at a first end, and a second cross-section and an opening at a second end, the wall thickness of the cup varying from the first end to the second end in a manner that causes a progressive collapse of the cup when a vacuum is drawn

at the first end, and the second end of the cup is closed by a human breast and teat (see figures 4, 5 and entire reference). With regards to claim 37 and 40, see figure 4, 5.

***Response to Arguments***

8. Applicant's amendments and arguments filed 3/01/07 have been fully considered and are persuasive. Therefore the 102 Rejection in view of Myers et al. (US Pub 2002/0193731) and the 102 Rejection in view of Ford (USPN 5,885,246) has been withdrawn.

9. With regards to the claims and the examiner interpretation of the term "fastening" the examiner uses the broadest dictionary definition of the term fastening, which is to place or secure or fix (the examiner uses Merriam-Webster Online), therefore in Silver et al. fastens the cup into the vacuum line of 48 by the ref 60 and 58. With regards to Atkins et al. discloses molding the cup into the main duct or conduit, therefore fastening the cup into the vacuum line, since negative pressure is applied to the main duct 12.

10. The applicant argues functional language with respect to the prior art. According to MPEP section 2114, when dealing with apparatus claims, as long as the same structure is found then the apparatus would be capable of performing those functions. This is the interpretation the examiner is applying to the prior art. Therefore the examiner maintains his rejection as well as applies a new reference because of the newly added claim.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto  
Art Unit 3763  
May 10, 2007

A handwritten signature in black ink, appearing to read "Matt DeSanto", is located below the typed name and date.